

IZUMI, Y. et al.
Appl. No. 10/087,998
March 15, 2004

REMARKS

This is in response to the Office Action dated December 15, 2003.

General Matters

Applicant has made a foreign priority claim under 35 U.S.C. Section 119.

Moreover, certified copies of both foreign priority documents were filed with the USPTO on April 18, 2002. Thus, it is respectfully requested that the Examiner acknowledge that certified copies of all foreign priority documents have been received by the USPTO.

Applicant has not yet received an initialed copy of the PTO-1449 corresponding to the IDS filed April 18, 2002. It is respectfully requested that the Examiner provide the undersigned with an initialed copy of the same.

The specification stands objected to in paragraph 1 of the Office Action. This objection is respectfully traversed. It is well known in the art that SiN_x refers to silicon nitride. Thus, it is respectfully submitted that the specification is clear in this regard. See also claim 21 above.

Claim 1

Claim 1 stands rejected under 35 U.S.C. Section 102(e) as being allegedly anticipated by Suga (US 6,234,031). This Section 102(e) rejection is respectfully traversed for at least the following reasons.

Claim 1 as amended requires "a protective film formed on the insulating film so as to cover the sense electrodes, wherein an entire upper surface of the insulating film is flat except for areas proximate the contact holes." Example advantages associated with the

flat upper surface of this layer are discussed at page 27, lines 15-25. The cited art fails to disclose or suggest this aspect of claim 1.

The instant specification explains that while prior art drawings appear to show flat surfaces, this is deceiving (pg. 4, lines 5-13). In reality, the insulating film surfaces in the prior art are not flat (i.e., any level difference greater than 0.5μ means non-flat as explained at page 4, line 10 of the instant specification).

Suga nowhere states or suggests that the top surface of film 102 is flat. To the contrary, the top surface of Suga's film 102 will be non-flat because of the array of protruding electrodes 103 located thereunder. Furthermore, it is well established that drawings of a patent such as Suga may not be relied on to show particular sizes or dimensions if the specification of the patent is silent on the issue. *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000), citing, *In re Wright*, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977). Moreover, M.P.E.P. Section 2125 confirms this by explaining that "proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale." Suga has no statement indicating the drawings are to scale. Thus, Suga cannot be used to show a "flat" upper surface of layer 102 (it is noted that the upper surface of layer 129 in Fig. 8A of Suga also is not flat). The cited art thus fails to disclose or suggest the invention of claim 1 in this regard.

Moreover, Suga's layer 102 has no contact holes defined therein. Again, this additional aspect of claim 1 also is not disclosed or suggested by Suga.

It is further noted that in Figs. 6-7, Suga forms a capacitive element 109 by a detection electrode 103 and a flexible electrode 106. Hence, the technique for detection in Suga is different from that of certain example non-limiting embodiments of this invention.

Other Claims

Claim 5 requires that the "insulating film has photosensitivity." This means that the insulating film can be etched using radiation. In contrast, the cited art fails to disclose or suggest this aspect of claim 5. Pires, cited in the Office Action, uses a luminous substance, but does not disclose or suggest photo-etching (or photo-definability) as required by claim 5.

Claim 26 requires that "the upper surface of the insulating film is characterized by differences in level no greater than 0.5 μm." E.g., see the instant specification at page 4, line 10. Suga clearly fails to disclose or suggest this aspect of claim 26.

Conclusion

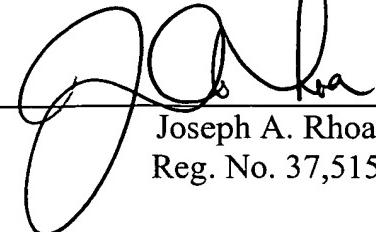
For at least the foregoing reasons, it is respectfully requested that all rejections be withdrawn. All claims are in condition for allowance. If any minor matter remains to be resolved, the Examiner is invited to telephone the undersigned with regard to the same.

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Respectfully submitted,

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